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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,720	12/28/2000	Isao Yagasaki	826.1658	6774
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER BORISSOV, IGOR N	
			ART UNIT 3628	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/749,720	Applicant(s) YAGASAKI ET AL.	
	Examiner Igor N. Borissov	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Amendment received on 3/09/2007 is acknowledged and entered. Claims 14-19 have been canceled. Claim 12 has been amended. Claims 1-13 are currently pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per Claim 13, the preamble of the claim is directed to a "method of simulating relation", while the body of the claim does not recite this feature, which is confusing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21 (2) of such treaty in the English language.

Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Rothman et al. (US 6,505,168).

Rothman et al. (Rothman) teaches a promotion method, system and computer-readable recording medium having instructions embedded therein for performing said method, comprising:

Claim 4. Said system, comprising:

a storing device storing a plurality of membership qualification tables of a plurality of services in a membership qualification system, each of the plurality of membership qualification tables including qualification criterion information for qualifying membership of a corresponding service (Fig. 4; items 22 and 24), and defining a prescribed service of which a user ought to be a member to have a membership qualification for the corresponding service, and identification information of a first service of the plurality of services being included by qualification criterion information for qualifying membership of a second service of the plurality of services for indicating the prescribed service (C. 10, L. 21-33);

a receiving device receiving information of a user for whom membership qualification is performed (Fig. 4; items 28);

a first determining device (preference engine 20) determining, in response to the information of the user, whether the user is utilizing the first service when the user wants to become a member of the second service, and

second determining device (match engine 30) determining that the user has a membership qualification for the second service by referring to the membership qualification table (32) of the second service and checking that the identification information of the first service is included in the qualification criterion information of the second service when the user is utilizing the first service (C. 10, L. 35-39).

Claim 1. Said system, wherein said storing device stores a plurality of service tables of the services, each of which includes a membership condition of a corresponding service, wherein said receiving device receives from the user a request to present an available membership service for the user (C. 4, L7-8), and wherein said processing system further comprises:

a selecting device extracting, from among the plurality of service tables, a first membership condition from a service table of a current service of which the user has become a member and a second membership condition from at least one service table of at least one other service of which the user has not become a member in response to

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the request, comparing the first and second membership conditions, and selecting an eligible service of which the user can become a member, and a presenting device presenting information to the user about the eligible service of which the user can become a member (C. 10, L. 28-55).

Claim 2. Said system, wherein when the user is a member of at least two services, said selecting device totals membership conditions of the at least two services using an AND operation and compares a totaled membership condition with the second membership condition of the service of which the user has not become a member (evaluating eligibility of the shopper by comparing shopper's criteria against promotion table criteria) (C. 10, L. 21-39).

Claim 3. Said system, comprising a registering device registering common certificate information (matching condition) that is in common with the at least two services, wherein said receiving device receives certificate information (identity) of the user, and wherein, when the certificate information of the user corresponds to the common certificate information said selecting device obtains the membership conditions of the at least two services based on the certificate information of the user (C. 10, L. 21-39).

Claim 5. Said system, comprising a registering device registering certificate information for a service that the user is utilizing, wherein said receiving device receives identification information of the certificate information of the user, and wherein when the identification information corresponds to the registered certificate information, said first determining device obtains information about the service that the user is utilizing based on the identification information and determines whether or not the user is utilizing the first service (C. 10, L. 21-39).

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Claim 6. Said system, comprising:

a storing device storing a plurality of service tables of a plurality of existing services in a membership qualification system, each of the plurality of service tables including a membership condition of a corresponding service of the plurality of existing services (Fig. 4; items 22 and 24);

a designating device designating a new membership condition (Fig. 4; item 14);
a simulating device (Fig. 4; item 30) comparing each membership condition of the service tables of the existing services with the new membership condition, adding information of users who are members of an existing service to a member count table when the new membership condition satisfies an old membership condition of the existing service, and obtaining new member information about a number of users who can become members of another service corresponding to the new membership condition by counting a number of pieces of information contained in the member count table (evaluating eligibility of the shopper by comparing shopper's criteria against promotion table criteria) and outputting the new member information (C. 10, L. 21-39).

Claim 7. Said system, comprising:

a registering device registering a plurality of pieces of certificate information of the plurality of users who are utilizing the existing services (identifying are shoppers members), wherein said simulating device adds certificate information of the users who are the members of the existing service to the member count table when the new membership condition satisfies the old membership condition of the existing service, counts a number of the pieces of certificate information contained in the member count table, and obtains the number of users who can become the members of the other service corresponding to the new membership condition (evaluating eligibility of the shopper by comparing shopper's criteria against promotion table criteria) (C. 10, L. 21-39).

Claim 9. Said computer-readable recording medium on which at least one program for a computer is recorded, said program comprising:

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receiving information of a user for whom membership qualification is performed (C. 10, L. 21-33);

determining whether the user is utilizing a first service in a membership qualification system using membership qualification tables of services, each of the membership qualification tables including qualification criterion information for qualifying membership of a corresponding service and defining a prescribed service of which a user ought to be a member to have a membership qualification for the corresponding service, when the user wants to become a member of a second service in the membership qualification system based on the identification information of the first service included in the qualification criterion information for qualifying membership of the second service and

determining that the user has a membership qualification for the second service by referring to the membership qualification table of the second service and checking that the identification information of the first service is included in the qualification criterion information of the second service when the user is utilizing the first service (C. 10, L. 21-39).

Claim 8. Said system, wherein by said receiving the computer receives from the user a request to present an available membership service for the user, and wherein said method further comprises:

extracting, in response to the request, from among a plurality of service tables of the services, each of which includes a first membership condition of a current service of which the user has become a member, and a second membership condition from at least one service table of at least one other service of which the user has not become a member (C. 10, L. 21-39);

comparing the first and second membership conditions (Fig. 4; item 30);

selecting an eligible service of which the user can become a member, and presenting information to the user about the eligible service of which the user can become a member (C. 10, L. 21-39).

Claim 10. Said computer-readable recording medium on which at least one program for a computer is recorded, said at least one program causing the computer to perform:

- storing service tables of existing services, each of the service tables including a membership condition of a corresponding service of the existing services (Fig. 4; C. 10, L. 21-33);

- designating a new membership condition (Fig. 4; item 16);

- comparing each membership condition of the service tables of the existing services in a membership qualification system with the new membership condition (Fig. 4; item 30);

- adding information of users who are members of an existing service to a member count table when the new membership condition satisfies an old membership condition of the existing service (Fig. 4; item 30);

- obtaining new member information about a number of users who can become members of another service corresponding to the new membership condition by counting a number of pieces of information contained in the member count table (C. 10, L. 21-33);

- outputting the new member information (Fig. 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothman et al.

Claim 12. Rothman teaches said method, comprising:

referencing the qualification criterion information for qualifying membership of a first service in a membership qualification system using membership qualification tables of services, each of the membership qualification tables including qualification criterion information for qualifying membership of a corresponding service and defining a prescribed service of which a user ought to be a member to have a membership qualification for the corresponding service, when a user wants to become a member of the first service (C. 10, L. 21-33);

receiving information of a user for whom membership qualification is performed determining, in response to the information of the user, whether the user is utilizing a second service in the membership qualification system based on the identification information of the second service included in the qualification criterion information (C. 10, L. 21-33);

determining that the user has a membership qualification for the first service by referring to the membership qualification table of the first service and checking that the identification information of the second service is included in the qualification criterion information of the first service when the user is utilizing the second service (C. 10, L. 21-33);

presenting a qualification result (C. 10, L. 21-33).

Rothman does not explicitly teach that said presenting step includes displaying a qualification result on a screen.

However, Rothman teaches that said method is implemented on a computer, thereby suggesting said feature.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rothman to include that said presenting step includes displaying a qualification result on a screen, because it would advantageously allow to avoid using paper in the process.

Claim 11. Said method as set forth in claim 12, wherein said storing includes storing a plurality of service tables of the services, each of the service tables

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including a membership condition of a corresponding service (Fig. 4), wherein said receiving includes receiving from the user a request to present an available membership service for the user (C. 4; L. 7-8), wherein said processing method further comprises:

- extracting, in response to the request, from among the plurality of service tables, a first membership condition from a service table of a current service of which the user has become a member and a second membership condition from at least one service table of at least one other service of which the user has not become a member (Fig. 4);

- comparing the first and second membership conditions (Fig. 4; item 30);

- selecting an eligible service of which the user can become a member, and

wherein said displaying includes displaying information about the eligible service of which the user can become a member on the screen (C. 10, L. 21-39).

Claim 13. Said method, comprising:

- storing service tables of existing services, each of the service tables including a membership condition of a corresponding service of the existing services (Fig. 4; item 24);

- designating a new membership condition (Fig. 4; item 16);

- comparing each membership condition of the service tables of the existing services in a membership qualification system with the new membership condition (Fig. 4; item 30);

- adding information of users who are members of an existing service to a member count table when the new membership condition satisfies an old membership condition of the existing service (Fig. 4; item 32);

- obtaining new member information of a number of users that can become members of another service corresponding to the new membership condition by counting a number of pieces of information contained in the member count table (C. 10, L. 21-39);

- presenting a qualification result (C. 10, L. 21-39).

Rothman does not explicitly teach that said presenting step includes displaying a qualification result on a screen.

However, Rothman teaches that said method is implemented on a computer.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rothman to include that said presenting step includes displaying a qualification result on a screen, because it would advantageously allow to avoid using paper in the process.

Response to Arguments

Applicant's arguments filed 3/09/2007 have been fully considered but they are not persuasive.

In response to applicant's argument that it is not understood why the operations recited in the body of claim 13 are not considered to constitute "simulating relation between a membership condition for a service and a number of users", it is noted that the recited method steps of: "storing service tables ... including a membership condition of a corresponding service of the existing services"; "designating a new membership condition"; "obtaining new member information of a number of users that can be become members of another service corresponding to the new membership condition ... and displaying the new member information" do not include the "simulating" feature. The recited method steps comprise merely storing data, receiving data, and displaying data, without any recitation of imitative representation of a system or method by means of the functioning of another system or process, including a computer.

In response to applicant's argument that the prior art fails to disclose "membership qualification" feature, it is noted that Rothman et al. discloses a computer-implemented system and method wherein the user is awarded with a second service if it is determined that the user is qualified to receive the second service. Specifically, Rothman et al. discloses storing customer information including previous credit card

transactions and customer profiles, and determining based on said stored information whether the customer is qualified for the second service by referring to the matching table (Fig. 4, C. 10, L. 21-39). While Rothman et al. does not employ the specific terminology (including the words "membership" and "qualification"), the arrangement disclosed in Rothman et al. reads on the claims of the current application.

The remaining applicant's arguments essentially repeat the arguments presented above; therefore, the responses presented by the examiner above are equally applicable to the remaining applicant's arguments.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

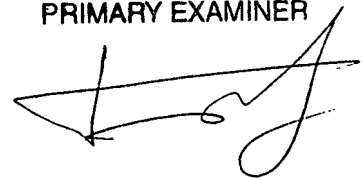
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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB

5/21/2007

IGOR N. BORISSOV
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Igor N. Borissov', written over the printed name and title.